

REMARKS

The examiner is thanked for the performance of a thorough search. By this amendment, Claims 3, 5, 8, 14, 16, 18, and 19 have been amended. No claims have been cancelled or added. Hence, Claims 1-20 are pending in the application. The amendments to the claims as indicated herein do not add any new matter to this application. Furthermore, amendments made to the claims as indicated herein have been made to exclusively improve readability and clarity of the claims and not for the purpose of overcoming alleged prior art.

Each issue raised in the Office Action mailed 10/24/2003 is addressed hereinafter.

I. ISSUES NOT RELATING TO PRIOR ART

A. Claim Rejections – 35 U.S.C. § 112

Claims 5-10, 16-19 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Claims 5 and 16 have been modified to use the article “a” to introduce the term “client”, thereby providing antecedent basis.

II. ISSUES RELATING TO PRIOR ART

1. Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Amstein et al. [U.S. Patent No. 5,793,966], in view of Ainsbury et al. [U.S. Patent No. 6,078,0924]. The rejection is respectfully traversed.

The Office Action treats together the rejection of Claims 1, 11, 12, and 20. Although these claims are different from one another, since the Office Action rejects them on the same grounds, the Applicant will discuss the allowability of Claims 1, 11, 12, and 20 together. The Office Action asserts that, regarding claims 1, 11, 12, and 20, “Amstein discloses the invention

substantially as claimed including a method of controlling use of a network resource, comprising the steps of:

accessing and navigating the network resource [col 1, lines 14-19 and lines 61-67];

detecting request and response messages that are generated during the navigating [86, Figure 3; and col 12, lines 21-31];

creating and storing an access and navigating script based on the request and response message [col 11, line 65-col 12, line 9].” The Office Action further asserts that Amstein does not teach, but Ainsbury does teach:

“modifying the access and navigating script to result in creating and storing a generalized script that can accept context specific request and response information when used in an actual user navigation of the network resource [Abstract; col 3-lines 27-38; and col 22, lines 1-28].”

The Office Action further contends:

“It would have been obvious to a person [with ordinary] skill in the art at the time the invention was made to combine the teaching of Amstein and Ainsbury because Ainsbury’s teaching would provide an application that automated collection of data, provided a method for organizing the library of information and provided analysis using multiple content types [Ainsbury, col 2, lines 33-38].” The phrase “[with ordinary]” was added as it is believed that the Examiner intended to include this phrase in the original Office Action.

The foregoing rejection is incorrect.

Each of the limitations in Claims 1, 11, 12, and 20 is individually patentable over the prior art of record. For example, consider the limitation “modifying the access and navigating script to result in creating and storing a generalized script that can accept context specific request and response information when used in an actual user navigation of the network resource.” The Office Action concedes that this feature is not taught in Amstein. In the sections cited in the

Office Action, Ainsbury describes creating a case template from a case. In Ainsbury, a “case” is a technique for doing “market research and analysis” [col 11, lines 45-50]. There is no suggestion in Ainsbury of 1) a navigation script, 2) modifying the navigation script, 3) creating a generalized script, 4), context specific requests, 5) user navigation of a network resource, or 6) a generalized script that can accept context specific request and response information when used in an actual user navigation of the network resource. Therefore, Ainsbury cannot possibly teach “modifying the access and navigating script to result in creating and storing a generalized script that can accept context specific request and response information when used in an actual user navigation of the network resource.”

In addition, whereas Ainsbury discloses techniques for creating case templates from cases, there is no suggestion of applying these techniques outside of market research and analysis.

To further clarify, consider an embodiment of the Applicant’s techniques where the user navigation script requires, as context-specific information, the user name and password of the user. The Applicants’ techniques use the user name and password to provide a context-specific version of the navigation script which could be, for example, a navigation of a website which requires a user to “log in” in order to navigate. This embodiment illustrates how the Applicant’s broader techniques, which can provide context-specific navigation, are fundamentally different from the techniques disclosed by Ainsbury, which provide data analysis templates. In addition, since Ainsbury makes no suggestion of using its techniques outside market research and analysis, they could not possibly be applied to modifying an access and navigation script.

Further, there is no suggestion in the references or elsewhere to combine the prior art references. “It is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section.” *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ

769, 775 (Fed. Cir. 1983). “[The factual inquiry whether to combine references] must be based on objective evidence of record.” *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). The Office Action cites as objective evidence of record to combine the two references the passage in Ainsbury at Col 2 lines 33-38:

“It would be advantageous to provide an application that automated the collection of data, provided a method for organizing the library of information and provided analysis using multiple content-types, and thereby provide a market understanding necessary to execute rapid and knowledgeable decision-making.”

The contention to combine the references is not taken from the references or any other technical source, but is hindsight based on Applicants’ disclosure. A rationale to combine must come from the references or another competent technical source, not from hindsight gained through review of the Applicant’s disclosure. *In re Gorman*, 933 F. 2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir 1991). Neither the above cited section nor any other section of Ainsbury or Amstein suggests the combination of Ainsbury, which describes an application that automates the collection of data, provides a method for organizing a library of information, and provides analysis using multiple content-types, with Amstein, which describes a client-side application that enables server-side authoring based on commands collected at the client side and executed on the server side. The cited section simply states that it would be advantageous to provide the invention of Ainsbury. Therefore, since there is no evidence supporting the combination of the two references, the rejection is unsupported and the Applicant respectfully requests that it be withdrawn.

Since Claims 1, 11, 12, and 20 are non-obvious over Amstein in view of Ainsbury, Amstein and Ainsbury are incorrectly combined, and Ainsbury makes no suggestion of using its

techniques outside of market research and analysis, the Applicant respectfully traverses the rejection of Claims 1, 11, 12, and 20.

2. Claims 2-7 were rejected in the Office Action and each depends directly or indirectly from Claim 1 and further limits Claim 1. The dependent claims also incorporate each and every feature of the independent claim from which they depend. Since independent Claim 1 is allowable, as discussed above, Claims 2-7 are also allowable. In addition, each of the dependent Claims 2-7 independently introduces one or more limitations that independently render it patentable over the prior art of record.

For example, regarding Claim 5, the Office Action suggest that the Ainsbury patent teaches:

“accessing the generalized script to obtain a request template corresponding to the client request; [col 3, lines 15-21]
merging contemporaneous information that is specific to the client request into the request template to result in creating a context-specific request [col 15, lines 47-55; and col 46, lines 16-24];
communicating the context-specific request to the network resource. [col 15, lines 61-64].”

This is incorrect. In the cited sections, Ainsbury discloses techniques for updating and replicating a data catalog. Ainsbury does not disclose 1) the generalized script; 2) a request template corresponding to the client request; 3) accessing the generalized script to obtain a request template corresponding to the client request; 4) information that is specific to the client request; 5) a context-specific request; 6) merging contemporaneous information that is specific to the client request into the request template to result in creating a context-specific request; or 7) communicating the context-specific request to the network resource. Therefore, Ainsbury could not possibly teach the features of this claim.

In addition, as discussed above, Ainsbury makes no suggestion of applying techniques outside of the field of market research and analysis. Also as discussed above, there is no suggestion to combine Amstein and Ainsbury. Therefore, Claim 5 is not obvious in view of Amstein in view of Ainsbury and the rejection is respectfully traversed.

3. Regarding Claim 8, The Office Action states that Claim 8 was rejected for “similar reasons as stated above in claims 1 and 5.” Claim 8 is not the same as a combination of Claims 1 and 5. Claim 8, however, is allowable for the same reasons set forth in the Remarks above for Claims 1 and 5.

4. Claims 9-10 were rejected in the Office Action and each depends directly or indirectly from Claim 8 and further limit Claim 8. The dependent claims also incorporate each and every feature of the independent claim from which they depend. Since independent Claim 8 is allowable, as discussed above, Claims 9-10 are also allowable. In addition, each of the dependent Claims 9-10 independently introduces one or more limitations that independently render it patentable over the prior art of record.

For example, regarding Claim 9, the Office Action states that claim 9 is rejected for the same reasons as Claim 6. Whereas Claims 6 and 9 are different, the Applicant will discuss the rejection of Claim 6 as if applicable to Claim 9. The Office Action alleges that Ainsbury teaches:

“receiving a context-specific response from the network resource [col 5, lines 3-7];
accessing the generalized script to obtain a response template corresponding to the
context-specific response [col 5, lines 30-38];
modifying the context-specific response according to the generalized script [col 3, lines
35-38];
communicating the modified response to the client [col 5, lines 45-55].”

This is incorrect. The cited sections describe a catalog of analysis templates that a user can access to perform analysis on data and do not teach the features of Claim 9. In addition, in the same paragraph as the cited text, Ainsbury specifically states that:

”Users can find an information source using a variety of different navigation paths [col 3, lines 57-58]”

This statement teaches away from the Applicant’s techniques and specifically teaches away from the features of Claim 9 and Claim 8, on which it depends. Specifically, in addition to teaching away from other limitations, the foregoing quote in Ainsbury teaches away from 1) merging contemporaneous information that is specific to the client request into the request template to result in creating a context-specific request and 2) communicating the context-specific request to the network resource. In an embodiment of the Applicant’s techniques, a user’s path is constrained and controlled by the generalized script. In the Ainsbury patent, the user can navigate as desired and, after navigating, create or use Analysis templates.

Therefore, it is clear that the Claim 9 is not obvious over Amstein in view of Ainsbury. Therefore, the rejection of Claim 9 is respectfully traversed.

5. Claims 13-18 were rejected in the Office Action and each depends directly or indirectly from Claim 12 and further limit Claim 12. The Office Action rejects Claims 13-18 for similar reasons as stated for Claims 2-7. Although these claims are not the same, since the Office Actions treat them similarly, the Applicant will limit discussion of the rejection of each Claim 13-18 to the rejection of the corresponding Claims 2-7. The dependent Claims 13-18 incorporate each and every feature of the independent Claim 12 from which they depend. Since independent Claim 12 is allowable, as discussed above, Claims 13-18 are also allowable. In addition, each of the dependent Claims 13-18 independently introduces one or more limitations that independently render it patentable over the prior art of record.

For example, regarding Claim 16, its features introduce one or more limitations that independently render it patentable over the prior art of record. For discussion of this, please see Section 2 above (re Claim 5).

For example, regarding Claim 17, its features introduce one or more limitations that independently render it patentable over the prior art of record. For discussion of this, please see Section 4 above (re Claims 6 and 9).

8. Regarding Claim 19, the Office Action states that this claim is rejected “for similar reasons as stated above in Claims 8 and 12.” The rejection is incorrect. Please see Section 3 (re Claim 8) and Section 1 (re Claim 12) above for discussion. Therefore, since Claim 19 is non-obvious over Amstein in view of Ainsbury, Amstein and Ainsbury are incorrectly combined, and Ainsbury makes no suggestion of using its techniques outside of market research and analysis, the Applicant respectfully traverses the rejection of Claim 19.

III. CONCLUSIONS & MISCELLANEOUS

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a check for the petition for extension of time fee is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

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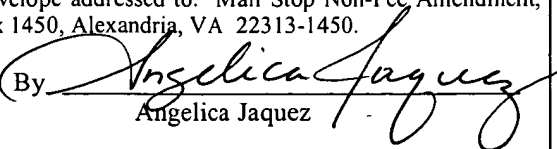
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On January 19, 2004

By


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